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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/236,339	01/25/1999	SEIICHI KASHIWABA	865.4327	1626

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/236,339

Applicant(s)

KASHIWABA ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003 and 24 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-11, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/24/2003 has been entered.

Response to Amendment

2. The present Office action is made in response to the amendment (Paper No. 29) filed on 3/26/2003. It is noted that in the mentioned amendment, applicant has amended claims 1-2, 7, 9, 11, and 19-20 and simultaneously canceled claims 21-22. As a result, the pending claims are now claims 1-3, 6-11, and 19-20 which are examined in this Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 7 is rejected under 35 USC 112, second paragraph for the following reasons: The claim recites a friction preventing member disposed between the

coupling member and the second holding member while the base claim 1 indeed recites a so-called deformation restricting member disposed between the coupling member and the second holding member (see claim 1, lines 13+). As a result, it is unclear about the structural relationships between the two recited members disposed between the coupling member and the second holding member.

b) Claim 9/7/1 is confusing. The claim 7 recites a friction preventing member located between the coupling members and the second holding member (see claim 7, lines 2-3), and claim 9 recites that the mentioned friction preventing member is the deformation restricting member recited in base claim 1. As such, it is unclear how many member(s) located between the coupling members (145) and the second holding member (118).

c) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 9/7/1 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-3 and 6-11, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa (U.S. Patent No. 4,780,640, of record).

Hasegawa discloses an optical system having a second holding member (1a) supporting an optical element in the form of a cathode ray tube (1), a first holding member (2) supporting another optical element in the form of a lens (11), and a coupling apparatus for coupling the two mentioned holding members. The coupling system comprises a plurality of screws (6) for coupling the first and second holding members via the components (5a and 2l) by press contact, a plurality of urging members (10) in the form of deformable washer disposed between each of the screw 96) and the second holding member (1a), and a plate (5) disposed between each of the coupling member and the second holding member. It is noted that the present claims do not recite any specific features/limitations relating to the so-called "deformable restricting member" and the plate (5) in the device of Hasegawa acts as a member for preventing the

deformation of the first holding member during the coupling between the holding members.

The holding members and the coupling system when completely being assembled has the deformable plate (5) located between the coupling member and the second holding member, the washer located between the coupling member and the plate, and each of the coupling member, screw, will go through the holes formed on each of the plate, the second holding member, and the first holding member. Each of the holding members comprises supporting members (1b and 2l) so that the optical axes of the tube and the lens will be able to keep in alignment to each other. The operation on the coupling members will permit a relative movement of the holding members with respect to each other in a vertical direction. In other words, one skilled in the art will recognize that the process of assembling the system will require a first step of adjusting the holding members for the purpose of making an initial alignment between the optical elements and the holes formed on the holding members before the coupling members are used for coupling the members.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claims 1-3, 6-9, 11, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sezerman (U.S. Patent No. 4,889,406) in view of Kohno (U.S. Patent No. 5,652,922) (both of record).

See the rejection as set forth in the previous Office action (Paper No. 24, pages 6-8).

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sezerman in view of Kohn as applied to claim 7 above, and further in view of Hasegawa (U.S. Patent No. 4,780,640, of record).

See the reasons as set forth in the previous Office action (Paper No. 22, pages 9-10).

Response to Arguments

12. Applicant's arguments as set forth in the amendment (Paper No. 29, pages 10-13) filed on 3/26/03 have been fully considered but they are not persuasive.

First, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second, applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. In particular, applicant has argued that the combined product provided by Sezerman and Kohno discloses a deformable angular ring, but it does not disclose a deformable restricting member as that of the inventive device. The Examiner

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respectfully disagrees with the applicant's viewpoint and respectfully invited the applicant to review the present application and the art of Sezerman. The use of the ring, i.e., ring 32, in the device of Sezerman and the use of the ring (119) in the present application are so similarly. Both are located between two elements which are affected by the force of screws. The material of the ring 32 is a resilient material which is deformable as that of the material used in the ring (119) of the present application. See Sezerman, columns 5-6. Further, the present claims fail to recite any specific limitations of the ring (119) to make it different or distinguish from that of prior art.

Third, with regard to applicant's arguments concerning the art of Kohno and the art of Hasegawa, the Examiner respectfully disagrees with the applicant's opinion because all of the features concerning the restricting member are disclosed by the primary reference, i.e., the art of Sezerman. The art of Kohno and Hasegawa are used as secondary reference(s) in the combination with the art of Sezerman for the purpose of showing one skilled in the art the interchangeability of an element in a set of elements.

Allowable Subject Matter

13. Claims 19 and 20 are allowed.

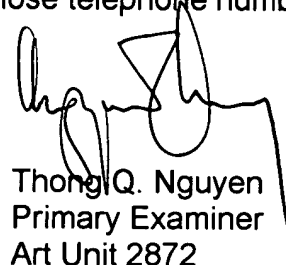
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (703) 305-0024. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

July 11, 2003